UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,705	08/25/2003	Doron Friedman	F0011/7006	2857

21127	7590	08/28/2006

KUDIRKA & JOBSE, LLP
ONE STATE STREET
SUITE 800
BOSTON, MA 02109

EXAMINER
JEAN, FRANTZ B

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 August 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/15,22/03,12/14/</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This is a first office action in response to application for patent filed 08/25/03. Claims 1-

35 are presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/15/03, 12/22/03 and

12/14/05 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statement is being considered by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).
Claims 1-35 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,965,912.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the claims of the instant application are broader than the claims of

patent number "912, which encompass the same metes and bounds. It has been held

that omission of an element and its function and a combination where the remaining

elements perform the same function as before involves only routine skill in the art. See

in re Karlson, 136 USPQ 184.

Claims 1-35 of the instant application are provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24

of copending patent application publication number 2004/0177114A1 and copending

patent Application Publication No.2006/0036681A1. Although the conflicting claims are

not identical, they are not patentably distinct from each other because the claims of the

instant application are narrower than the claims of copending patent application

publication number "114" and copending patent application publication number "681",

which encompass the same metes and bounds. It has been held that omission of an

element and its function and a combination where the remaining elements perform the

same function as before involves only routine skill in the art. See in re Karlson, 136

USPQ 184.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

During patent examination, the pending claims have been "given" their
broadest reasonable interpretation consistent with the specification." In re Hyatt,
211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Small US patent number 5,513117.

As per claim 1, Small teaches in a computer system connectable to a computer

network, a method comprising: (a) maintaining in memory a compilation of greeting card

templates; (b) maintaining in memory data identifying one of the greeting card templates

and any user defined modifications thereto; (c) maintaining in memory data associating

said one greeting card template and any user defined modifications thereto with a gift

card; (d) printing on demand a personalized greeting card comprising the identified

greeting card template in conjunction with any user defined modifications thereto and

greeting card data reference thereon; and (e) generating a gift card having a gift card

data reference thereon; (f) comparing the greeting card data reference and the gift card

data reference to determine a relationship therebetween (see fig 1-4, and 7-9; col. 2 line

30 to col. 3 line 59).

As per claim 2, Small teaches the method of claim 1 further comprising: (g) combining the gift card with the personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 3, Small teaches the method of claim 1 further comprising: (g) shipping the gift card with the personalized greeting card to a designated recipient (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 4, Small teaches the method of claim 1 wherein the personalized greeting card template has a front panel wherein (d) comprises: (d1) printing front panels of the personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 5, Small teaches the method of claim 1 wherein the gift card has at least two panels and wherein (e) comprises: (e1) printing a first of the at least two gift card panels (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 6, Small teaches the method of claim 5 wherein (e) comprises: (e1a) printing at least a first of the two gift card panels with at least a portion of an image from at least one panel of the personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 7, Small teaches the method of claim 1 wherein (f) comprises: (f1) reading

the greeting card reference data; (f2) reading the gift card reference data; and (f3)

confirming that the personalized greeting card represented by the read greeting card

reference data and gift card represented by the read gift card reference data are

associated (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 8, Small teaches the method of claim 2 wherein (g) comprises: (g1)

attaching the gift card to a panel of the greeting card (see fig 1-4, and 7-9; col. 2 line 30

to col. 3 line 59).

As per claim 9, Small teaches the method of claim 2 wherein (g) comprises: (g1)

inserting the gift card into a panel of the greeting card (see fig 1-4, and 7-9; col. 2 line

30 to col. 3 line 59).

As per claim 10, Small teaches the method of claim 1 wherein (c) comprises: (c1)

maintaining in memory data representing any of a greeting card identifier, greeting card

modification identifiers, destination address, gift card identifier, gift card value, and

vendor transaction identifier (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 11, Small teaches the method of claim 1 wherein (d) comprises: (d1)

printing a personalized greeting card upon the occurrence of a predetermined event

selected from the group consisting of: receipt of a computer instruction, the occurrence

of a temporal event, and the notification of a completed task (see fig 1-4, and 7-9; col. 2

line 30 to col. 3 line 59).

As per claim 12, Small teaches in a computer system connectable to a computer network, a method comprising: (a) maintaining data associating a greeting card with the gift card; (b) generating on demand a personalized greeting card with a greeting card data reference thereon; (c) using the greeting card data reference to initiate generation of a gift card having a gift card data reference thereon; (d) reading the greeting card reference data; (e) reading the gift card reference data; and (f) determining if the personalized greeting card represented by the read greeting card reference data and gift card represented by the gift card reference are associated (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 13, Small teaches the method of claim 12 further comprising: (e) combining the gift card with the personalized greeting card, if the personalized greeting card represented by the read greeting card reference data and gift card represented by the gift card reference are associated (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 14, Small teaches the method of claim 12 further comprising: (e) shipping the gift card with the personalized greeting card to a designated recipient, if the personalized greeting card represented by the read greeting card reference data and gift card represented by the gift card reference are associated (see fig 1-4, and 7-9; col.

2 line 30 to col. 3 line 59).

As per claim 15, Small teaches the method of claim 12 wherein the personalized

greeting card comprises a greeting card template and any user defined modifications

thereto and wherein (b) comprises: (b1) printing a greeting card template in conjunction

with any user defined modifications thereto upon the occurrence of a predetermined

event (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 16, Small teaches the method of claim 15 wherein the predetermined

event is selected from the group consisting of: receipt of a computer instruction, the

occurrence of a temporal event, and the notification of a completed task (see fig 1-4,

and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 17, Small teaches in a computer system connectable to a computer

network, a method comprising: (a) maintaining data associating a personalized gift card

with a personalized greeting card; (b) generating a gift card with a gift card data

reference thereon; (c) using the gift card data reference to initiate generation of a

personalized greeting card having a greeting card data reference thereon; and (d)

comparing the gift card data reference and the greeting card data reference to

determine if a relationship exists therebetween. (see fig 1-4, and 7-9; col. 2 line 30 to

col. 3 line 59)

As per claim 18, Small teaches the method of claim 17 further comprising: (e) combining the gift card with the personalized greeting card, if a relationship exists associating the gift card with the personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 19, Small teaches the method of claim 17 further comprising: (e) shipping the gift card with the personalized greeting card to a designated recipient, if a relationship exists associating the gift card with the personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 20, Small teaches the method of claim 17 wherein (d) comprises: (d1) reading the greeting card reference data; (d2) reading the gift card reference data; and (d3) confirming that the personalized greeting card represented by the read greeting card reference data and gift card represented by the gift card reference are associated (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 21, Small teaches the method of claim 17 wherein (c) comprises: (c1) utilizing the gift card data reference to access one of a plurality of greeting card templates stored in memory in conjunction with any user defined modifications thereto and a greeting card data reference; and (c2) printing the greeting card template in conjunction with any user defined modifications thereto upon the occurrence of a predetermined event (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 22, Small teaches the method of claim 17 wherein the gift card has at least two panels and wherein (b) comprises: (b) printing at least one panel on gift card stock (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 23, Small teaches the method of claim 5 wherein the greeting card template has n panels where n>2 and wherein (c1) comprises: (c1a) printing greater than two panels on card stock (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 24, Small teaches in a computer system connectable to a computer network, a method comprising: (a) maintaining in memory data identifying a greeting card template and any user defined modifications thereto and data associating the gift card template with a gift card; (c) upon the occurrence of a first predetermined event, printing a personalized greeting card comprising the identified greeting card template in conjunction with any user defined modifications thereto and greeting card data reference thereon; (d) upon the occurrence of a second predetermined event, generating a gift card with a gift card data reference thereon; and (e) comparing the gift card data reference and the greeting card data reference to determine a relationship therebetween (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 25, Small teaches the method of claim 24 wherein one of the first and second predetermined events are selected from the group consisting of: receipt of a

computer instruction, the occurrence of a temporal event, and the notification of a completed task (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 26, Small teaches the method of claim 24 wherein the first and second predetermined events occur simultaneously (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 27, small teaches the method of claim 24 wherein the first and second predetermined events occur in a sequence (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 28, Small teaches in a computer system connectable to a computer network, a method comprising: (a) maintaining in memory a compilation of greeting card templates; (b) maintaining in memory data identifying a plurality of the greeting card templates, any user defined modifications thereto, and data associating each of the plurality of greeting card templates with one of a plurality of the gift cards; (c) printing, in a sequence, a plurality personalized greeting cards, each of the personalized greeting cards comprising one of the identified greeting card templates in conjunction with any user defined modifications thereto and a greeting card data reference thereon; and (d) generating, on demand and in a sequence, a plurality of a gift card, each gift card having a gift card data reference thereon; (e) comparing the greeting card data reference of a greeting card having a position in the sequence of personalized greeting

cards with the gift card data reference of a gift card having a similar position in
sequence of gift cards to determine a relationship therebetween (see fig 1-4, and 7-9;
col. 2 line 30 to col. 3 line 59).

As per claim 29, Small teaches the method of claim 28 further comprising: (f) combining
the gift card with the personalized greeting card, if the personalized greeting card
represented by the greeting card data reference and gift card represented by the gift
card data reference are associated (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 30, Small teaches the method of claim 28 wherein the gift cards have a
plurality of panels and wherein (d) comprises: (d1) printing at least one panel on gift
card stock (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 31, Small teaches the method of claim 28 wherein the gift cards have a
plurality of panels and wherein (d) comprises: (d1) printing at least one panel on gift
card stock with an image associated with the personalized greeting card (see fig 1-4,
and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 32, Small teaches the method of claim 28 wherein the gift cards have a
plurality of panels and wherein (d) comprises: (d1) printing at least one panel on gift
card stock with an image having a complementary theme with a panel of the associated
personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 33, Small teaches the method of claim 28 wherein the gift cards have a plurality of panels and wherein (d) comprises: (d) printing at least one panel on gift card stock with a user uploaded image with a panel of the associated personalized greeting card (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 34, Small teaches a computer program product for use with a computer system operatively coupled to a computer network comprises a computer usable medium having program code embodied thereon, the program code comprising: (a) program code for maintaining in memory a compilation of greeting card templates; (b) program code for maintaining in memory data identifying one of the greeting card templates and any user defined modifications thereto; (c) program code for maintaining in memory data associating said one greeting card template and any user defined modifications thereto with a gift card; (d) program code for printing on demand a personalized greeting card comprising the identified greeting card template in conjunction with any user defined modifications thereto and greeting card data reference thereon; and (e) program code for generating a gift card having a gift card data reference thereon; and (f) program code for comparing the greeting card data reference and the gift card data reference to determine a relationship therebetween (see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

As per claim 35, Small teaches a computer system connectable to a computer network

comprising: (a) a processor; (b) a memory coupled to the processor for storing; (i) data

identifying one of the greeting card templates and any user defined modifications

thereto; and (ii) data associating said one greeting card template with a gift card; (c) a

printer coupled to the processor; (d) program logic for printing on demand a

personalized greeting card comprising the identified greeting card template in

conjunction with any user defined modifications thereto and greeting card data

reference thereon; e) program logic generating a personalized gift card having a gift

card data reference thereon; and (f) program logic for comparing the greeting card data

reference and the gift card data reference to determine a relationship therebetween

(see fig 1-4, and 7-9; col. 2 line 30 to col. 3 line 59).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Tackbary et al. (5555496), Spector (5870718), Simpson (6453300)and

Chatuverdi et al (EP 0784394A1).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frantz B. Jean whose telephone number is 571-272-

3937. The examiner can normally be reached on 8:30-6:00   M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz Jean

FRANTZ B. JEAN
PRIMARY EXAMINER